

### Remarks

#### The § 102 (b) Rejections of Claims 1-3, 8-11 and 16

The Examiner rejected Claims 1-3, 8-11, and 16 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 5,691,841 to Ohsaki, et al. ("Ohsaki" or "the Ohsaki patent"). Applicant respectfully traverses these rejections and requests reconsideration.

"Every element of the claimed invention must be literally present arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.) Applicant respectfully traverses the rejection of independent Claim 1 on the grounds that the Ohsaki patent fails to disclose each element as arranged and claimed in Claim 1. Applicant takes note of the fact the Examiner indicated that assembly 6 in Ohsaki comprises a housing analogous to the housing claimed in Claim 1. Applicant respectfully notes that Claim 1 in the instant application claims the housing as attached to the microscope stage. Applicant courteously points out that Figure 4 of Ohsaki clearly shows assembly/housing 6 is not attached to microscope stage 11. Therefore, for this first reason, the Ohsaki patent fails to anticipate Claim 1 as it does not disclose a housing attached to a microscope stage.

Additionally, Ohsaki fails to disclose an inner sleeve that fits within the housing. The Examiner states that reference no. 21 in Ohsaki is analogous to the inner sleeve claimed in Claim 1 of the instant application. Applicant respectfully traverses this statement and refers the Examiner to col. 4, lines 3-5 which describe item 21 as "outer drum 21". In addition, item 20 is described as "inner drum 20" which is "fixed onto an upper surface of substage 6." (See Ohsaki, col. 4, lines 1 and 2.) Moreover, Applicant respectfully notes that figures 3 and 4 of Ohsaki clearly show item 21 outside the assembly/housing 6 in the Ohsaki device. In contrast, figure 3 of the instant application clearly shows inner sleeve 32 positioned completely within or inside housing 36. See also paragraph 0020 of the instant application stating, "Inner sleeve 32 fits within housing 36 and is adapted to rotate within housing 36." Applicant respectfully submits that Ohsaki plainly does not anticipate Claim 1 as it does not disclose every element of Claim 1 as it is arranged and claimed. Specifically, it fails to disclose both the inner sleeve within the

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housing and the housing attached to the microscope stage. Applicant respectfully requests reconsideration and removal of the rejection of Claim 9 under 35 U.S.C. § 102 (b).

Similarly, the Ohsaki patent fails to anticipate independent Claim 9. Claim 9 also claims an inner sleeve fitting within the housing. As explained above, the analogous outer drum 21 in Ohsaki, described by the Examiner as analogous to the inner sleeve, is actually outside the assembly/housing in Ohsaki. For this reason, the Ohsaki patent fails to anticipate independent Claim 9 as it fails to disclose every element of Claim 9 as arranged in that claim. Applicant respectfully requests reconsideration and removal of the rejection of Claim 9 under 35 U.S.C. § 102 (b).

Claims 2, 3, and 8 depend from Claim 1 and Claims 10, 11, and 16 depend from Claim 9 and thus incorporate all the limitations of those respective claims. Because, as discussed above, the Ohsaki patent fails to anticipate all the elements of Claims 1 and 9, it also fails to anticipate Claims 2, 3, and 8 and 10, 11, and 16 respectively. Applicant respectfully requests the removal of the rejections of Claims 2, 3, 8, 10, 11, and 16 under 35 U.S.C. § 102 (b).

In addition, Applicant specifically traverses the rejection of Claims 2-3 and 10-11 as anticipated by Ohsaki. Claim 3 depends from Claim 2 and Claim 11 depends from Claim 10 and thus they incorporate all the limitations of those respective claims. Claims 2 and 10 each claim a housing further comprising a flange. The Examiner describes the portion of the assembly/housing covering the sleeve 21 as a flange. However, as explained above, outer drum 21 in Ohsaki is actually outside the assembly 6 and thus is the actual component that includes the flange. Therefore, the Ohsaki patent fails to disclose all the elements of Claims 2 and 10 as it fails to disclose a housing that includes a flange. Therefore, the Ohsaki patent fails as a reference under § 102 (b) to anticipate Claims 2 and 10 as it fails to disclose all the elements of Claims 2 and 10 as arranged in those claims. Because Claims 3 and 11 depend from Claims 2 and 10, respectively, the Ohsaki patent fails to anticipate those claims as well. For this additional reason, Applicant respectfully requests reconsideration and removal of the rejection of Claims 2, 3, 10 and 11 under § 102 (b).

The § 103 (a) Rejections of Claims 1-20

The Examiner rejected Claims 1-20 under 35 U.S.C. § 103 (a) as obvious over Japanese Reference No. 10-311952 ("the '952 reference") in view of U.S. Patent No. 6,560,012 to Adachi, et al. ("Adachi" or "the Adachi patent") and U.S. Patent No. 4,955,702 to Nakamura ("Nakamura" or "the Nakamura patent"). Applicant respectfully traverses these rejections and requests reconsideration.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Independent Claims 1, 9, and 17 each claim a housing and an inner sleeve fitting within the housing so that it rotates within the housing. Applicant respectfully submits that the cited references fail to disclose, teach or suggest an inner sleeve fitting into a housing such that it rotates within a housing. First, Applicant courteously points to the '952 reference. Applicant respectfully points out that the Examiner states component 203 is a housing when in actuality it is a microscope stage. (See paragraph 0004 of the '952 reference describing "stage 203".) Figure 10 of the '952 shows capacitor 201 fitting into the microscope stage not into a separate housing attached to the stage. Therefore, the '952 reference fails to teach or suggest either a separate housing attached to a microscope stage or an inner sleeve fitting within a housing because it fails to disclose, teach, or suggest any type of housing at all.

For this same reason, Applicant respectfully traverses the Examiner's statement the '952 patent discloses a housing further comprising a flange. Because there is no housing in the '952 reference, there can be no housing with a flange. Further, the flange 42 in the instant application is depicted as a flared rim that extends from the upper edge of the housing. The fastener in the '952 reference is shown as attached through the nonflared wall of stage 203. Therefore, the '952

reference fails to suggest either the limitation of a flanged housing claimed in Claims 3 and 10, because there is no housing, or a flange with a hole to receive a fastener claimed in Claims 4 and 11, because the fastener passes through the nonflanged wall of the stage.

Applicant also respectfully submits that Adachi fails to teach or suggest an inner sleeve fitted within and rotating within a housing. The Examiner cites the Adachi patent as teaching a housing attached to a microscope stage. However, like the '952 reference, nowhere in the Adachi patent is there a suggestion to fit a rotating inner sleeve inside or within a housing. Further, Applicant courteously takes note of the Examiner's statement on page 4 that Adachi teaches the attachment of a condenser assembly onto a microscope stage. As is well known in the art, a microscope condenser is an optical element that contains an assembly of lenses. Applicant respectfully submits that a person of ordinary skill in the art would not look to a condenser that is filled with lenses or other optical components to suggest or teach an open inner sleeve fitted within the condenser when there would be no available room for such an inner sleeve. In addition, a component such as a condenser in which the inner volume is filled with optical components would not suggest component such as an open housing with an inner sleeve when the object of the invention is to create sufficient open space below the stage to hold a sample at a suitable distance away from a microscope objective lens. Therefore, similar to the '952 reference, the Adachi patent fails to disclose or suggest an inner sleeve fitted within and rotating within a housing.

Regarding the Nakamura patent, as stated in the Reply of February 14, 2005, Nakamura fails to disclose a housing surrounding an inner sleeve that is rotatable within the sleeve. As noted in the previous Reply, the housing 10 in the Nakamura patent is described as rotating around a guide barrel 8. Clearly, this does not suggest the housing claimed in independent Claims 1, 9, and 17 in which an inner sleeve is claimed as rotating within a housing.

Therefore, it can be seen that the combination of the '952 reference, the Adachi patent, and the Nakamura patent fails to establish a *prima facie* case of obviousness against Claims 1, 9, and 17 as together they fail to suggest or disclose the claim element of a housing having an inner sleeve rotatable within that housing. The '952 reference fails to disclose any type of housing at

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all, let alone anything within the housing. The Adachi patent only discloses a condenser with no open well, no movable components within the condenser including an inner sleeve, and no open space for a well or inner sleeve within the condenser. Nakamura discloses a rotating housing, not a rotating inner sleeve. Thus together the combined references fail to disclose a housing with any rotating components within that housing, let alone a rotating inner sleeve. Applicant respectfully requests reconsideration and passage to allowance of independent Claims 1 and 9.

“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2-8 depend from Claim 1. Claims 10-16 depend from Claim 9. Claims 18-20 depend from Claim 17. Dependent claims incorporate all the limitations of their respective base claims. Because, as discussed above, the combined ‘952 reference, the Adachi patent, and the Nakamura patent fail to render obvious independent Claims 1, 9, and 17, they also fail to render obvious Claims 2-8, 10-16, and 18-20. Applicant respectfully requests the removal of the rejections of Claims 2-8, 10-16, and 18-20 and passage to allowance of those claims.



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**Conclusion**

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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